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10/038,545	10/24/2001	Katsumi Tomioka	P/1139-107	7121
32172	7590	09/28/2006	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			LEE, DAVID J	
		ART UNIT	PAPER NUMBER	
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**MAILED**  
**SEP 28 2006**  
**GROUP 2800**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/038,545

Filing Date: October 24, 2001

Appellant(s): TOMIOKA, KATSUMI

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Hua Gao  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10 July 2006 appealing from the Office action mailed on 08 February 2006.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

"Predetermine." Merriam-Webster's Collegiate Dictionary. 10th ed. 2000.

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tochio (US Patent No. 6,563,613) in view of Effenberger (US Patent No. 5,930,018). This rejection is detailed in the Final Office action mailed on 08 February 2006.

### **(10) Response to Argument**

The portion of the instant claim under controversy recites, "a transmission line distance monitor/processor unit which...judges whether the transmission line distance is larger or smaller than a predetermined reference value" (emphasis added). The cited prior art discloses, as submitted by Appellant, a transmission line distance monitor/processor unit which...judges whether the transmission line distance is larger or smaller than a previously measured reference value.

MPEP § 904.01 recites:

"The breadth of the claims in the application should always be carefully noted; that is, the examiner should be fully aware of what the claims do not call for, as well as what they do require. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

Appellant disagrees with Examiner's position that the term "predetermined reference value" can be broadly and reasonably interpreted to read upon the term "previously measured reference value":

"[Appellant] respectfully disagrees that the previously measured reference values in Effenberger read on the claimed 'predetermined reference value' ... [Appellant] strongly disagrees with the Examiner's characterization of Effenberger's **measured** value (e.g., previously measured distance of ONU1) to be a predetermined reference value as required in independent claims 1 and 5" (pg. 6, 2<sup>nd</sup> paragraph, pg. 7, 1<sup>st</sup> full paragraph, Appeal Brief, original emphasis)

First, it is noted that neither the term "predetermined" nor any of its variations are described, suggested, or even mentioned in the specification, so for the purposes of examination, Examiner has referred to the most relevant and commonly known definition of the word "predetermine" as defined by Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> edition:

*"predetermine, 1b: to determine beforehand."*

In light of this definition, the word "predetermined" is equated with the definition "determined beforehand." As submitted by Appellant and as suggested by the cited prior art, Effenberger teaches that the reference value is "previously measured." Hence, the controversy lies between the equation of the terms "determined beforehand" and "previously measured." Examiner submits that the word "previously" can be reasonably interpreted to read on the word "beforehand." Furthermore, it is noted that in order to "determine" a value, the value can be measured, calculated, estimated, or randomly selected. It is noted that the claim does not disclose how the determination of the reference value is made, i.e., whether by measurement,

calculation, estimation, random selection, etc. Hence, Examiner further submits that the word “determined” can be reasonably interpreted to read on the word “measured.”

For example, if one’s height was to be “determined,” an artisan could reasonably and clearly interpret this action to mean that the height was to be “measured.” More relevantly, if a distance was to be compared with a “determined” value, an artisan could reasonably interpret this action to mean that the distance was to be compared with a “measured” value. Likewise, if a distance was to be compared with a value “determined beforehand,” an artisan could reasonably interpret this action to mean that the distance was to be compared with a value “previously measured.” Furthermore, if a distance was to be compared with a “predetermined” reference value, an artisan could reasonably interpret this action to mean that the distance was to be compared with a “previously measured” reference value.

Accordingly, Appellant’s argument that the term “predetermined reference value” cannot be broadly and reasonably interpreted to read upon the term “previously measured reference value” is not persuasive. Appellant also mentions that Examiner is using hindsight to equate the two terms. However, it is noted that in view of the above explanation, an artisan would have clearly recognized at the time of invention that the term “predetermined reference value” could be broadly and reasonably interpreted to read upon the term “previously measured reference value.”

Additionally, Appellant argues that “Effenberger does not disclose comparing each transmission line distance with a predetermined reference value” (see pg. 8, 1<sup>st</sup> paragraph, Appeal Brief). It is noted that the instant claims do not disclose the limitation “comparing each transmission line distance with a predetermined reference value.” Rather, the claims disclose “a transmission line distance monitor/process unit which...judges whether the transmission line distance is larger or smaller than a predetermined reference value.” It is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. However, even so, Effenberger still reads on the unclaimed limitation above. It is parenthetically noted that Appellant does not challenge Examiner’s explanations of the sorting operation of Effenberger (see pg. 7, 1<sup>st</sup> full paragraph, Appeal Brief; see explanation of sorting operation of Effenberger at pg. 5, 1<sup>st</sup> full paragraph of Final Office action mailed 2/8/06). With regard to Examiner’s explanation of the sorting operation of Effenberger, it is noted that only ONU<sub>2</sub> through ONU<sub>4</sub> are considered “a plurality of subscriber units.” In the exemplary case, the distance value of ONU<sub>2</sub> would be compared to the predetermined reference value of ONU<sub>1</sub>, the distance value of ONU<sub>3</sub> would be compared to the predetermined reference value of either ONU<sub>2</sub> or ONU<sub>1</sub>, and the distance of ONU<sub>4</sub> would be compared to the predetermined reference value of ONU<sub>1</sub>, ONU<sub>2</sub>, or ONU<sub>3</sub>. Hence, each of the plurality of subscriber units, ONU<sub>2</sub>, ONU<sub>3</sub>, and ONU<sub>4</sub> would be compared to a predetermined reference value. Accordingly, Appellant’s argument that Effenberger does not disclose “comparing each transmission line distance with a predetermined reference value” is not persuasive.

**(11) Related Proceeding(s) Appendix**

Art Unit: 2613

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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September 20, 2006

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